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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,267	12/02/2003	Pijush K. Dewanjee	PU2185	1266
23454	7590	05/06/2005	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/707,267	Applicant(s) DEWANJEE ET AL.	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Disclaimer and §3.73 sample</u> . |

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DETAILED ACTION

This Office action is responsive to communication received 12/02/2003 – application papers filed; 03/15/2004 – IDS.

Claims 1-18 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5 and 14-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,238,302 in view of Hettinger, Jepson and Gojny. The claimed invention of the '302 Patent differs from the instant claimed invention in that the claimed invention of the '302 Patent does not require a thermoplastic polyurethane material. Instead, the claimed invention of the '302 Patent requires, in some instances, the use of a thermoset polymer material. Hettinger, Jepson and Gojny show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and

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col. 2, lines 35-45 in Gojny. See col. 1, lines 31-40 and col. 2, lines 48-63 and col. 3, lines 1-22 in Jepson. In view of the patents to Hettinger, Jepson and Gojny, it would have been obvious to modify the device in the claimed '302 Patent by replacing the insert with a material that is composed of thermoplastic polyurethane as required by the instant claims, the motivation being to alter the ball striking characteristics of the face. As to the specific properties of the claimed thermoplastic polyurethane materials as set forth in instant claims 16-18, it is clear that these properties are based upon the specific material selected. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired.

Claims 5 and 14-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6, 7 and 14-17 of copending Application No. 10/604,312 in view of Hettinger, Jepson and Gojny. **This is a provisional obviousness-type double patenting rejection.** The claimed invention of the '312 Application differs from the instant claimed invention in that the claimed invention of the '312 Application does not require a thermoplastic polyurethane material. Instead, the claimed invention of the '312 Application requires, in the broadest claim 1, a simple thermoplastic polyurethane, with dependent claim 6 requiring a more specific thermoplastic polyurethane material selected from the group consisting of 4,4'-diphenylmethane diisocyanate-polyester thermoplastic polyurethanes and a paraphenylene diisocyanate-polyether thermoplastic polyurethane. Hettinger,

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Jepson and Gojny show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and col. 2, lines 35-45 in Gojny. See col. 1, lines 31-40 and col. 2, lines 48-63 and col. 3, lines 1-22 in Jepson. In view of the patents to Hettinger, Jepson and Gojny, it would have been obvious to modify the device in the claimed '312 Application by replacing the insert with a material that is composed of thermoplastic polyurethane as required by the instant claims, the motivation being to alter the ball striking characteristics of the face. As to the specific properties of the claimed thermoplastic polyurethane materials as set forth in instant claims 16-18, it is clear that these properties are based upon the specific material selected. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection **over a prior patent (37 CFR 1.1321(b) and (c))**.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection **over a pending application (37 CFR 1.321(b) and (c))**.

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the

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Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel____, Frame____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland in view of Hettinger, Jepson and Gojny. The patent to Rowland shows every feature claimed with the exception of the specific thermoplastic polyurethane material claimed. Hettinger, Gojny and Jepson show it to be old in the art to provide a composite insert for the striking face portion of a club head in order to provide additional energy to a struck ball. See col. 4, lines 45-55 in Hettinger. See col. 1, lines 35-46 and col. 2, lines 35-45 in Gojny. See col. 1, lines 31-40 and col. 2, lines 48-63 and col. 3,

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lines 1-22 in Jepson. In view of the patents to Hettinger, Jepson and Gojny, it would have been obvious to modify the device in the cited art reference to Rowland by replacing the insert with a material that is composed of thermoplastic polyurethane, the motivation being to alter the ball striking characteristics of the face. Moreover, it is noted that Rowland suggests that other materials may be used as part of the striking face in order to change the impact force as well as the corresponding trajectory and the amount of ball spin (col. 5, lines 14-20). It is further noted that the claimed thermoplastic polyurethane materials are merely examples of thermoplastic materials that are commonly available. Clearly, the applicant has not invented the claimed materials. The skilled artisan, being familiar with the characteristics of known materials, would have found it obvious to select a suitable thermoplastic based upon the specific ball response desired. As to claim 4, Rowland uses adhesive to mount the insert within the recess. As to claim 7, the insert in Rowland includes a trapezoidal shape. As to claim 8, since adhesive or double-sided tape may be used to mount the insert (16) within the cavity in the body, it is clear that the depth of the recess must be greater, if only slightly, than the thickness of the insert so that the insert lies flush with the external striking surface of the club head body. Also, see Figure 9 in Rowland showing the depth of the recess in the front of the striking face. As to claims 9 and 10, the claimed limitations are not deemed critical. As to claim 11, the Rowland insert clearly makes up at least between 55 to 75 percent of the face area of the head. As to claim 12, Rowland clearly shows an iron-type club head.

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Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowland in view of Hettinger, Jepson, Gojny and Fisher ('132). Rowland in view of Hettinger, Jepson and Gojny has been discussed above. Rowland, as modified, lacks an indication that the insert may be used for a putter-style or wood-type club head. Fisher shows it to be old in the art to fashion an insert for the face of any one of a putter, iron or wood club head. As all of these types of clubs are used by a golfer throughout a routine round of golf, it is clear that a golfer would benefit from the advantage of having the insert material of Rowland in each of a putter and wood-type head in order to extend the benefit of the insert construction used in Rowland to other commonly used clubs. In this regard, Fisher goes on to explain the advantages of having his specific insert as part of the face of any one of a putter, iron or wood club head. In view of the patent to Fisher and the above reasoning, it would have been obvious to modify the device in the cited art reference to Rowland by introducing the details of the insert within the body of a putter or wood-type club head, the motivation being to likewise provide these commonly used clubs with the advantages of a specific insert material and specific mounting arrangement.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note Helmstetter ('832). Although no specific double-patenting matters have been addressed at this time with respect to this '832 Patent, applicant is respectfully urged to maintain a clear line of demarcation between the instant claims and the claims of the '832 Patent when amending the current set of claims. Halko,

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Baker and Wu show polyurethane materials used in the making of an insert for a club head.

The IDS of 03/15/2004 has been considered. However, it is noted that one of the citations on page 2 (U.S. Pat. No. 5,941,412) does not match the corresponding inventor name provided. Upon further review, it appears that applicant may be attempting to reference U.S. Pat. No. 5,951,412 to Rose et al. Clarification is requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
May 2, 2005

PTO/SB/28 (10-00)
Approved for use 10/31/2002. OMB 0651-0031
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TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT	Docket Number (Optional)
<p>In re Application of: Application No.: Filed: For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> _____ Signature </div> <div style="text-align: right; margin-top: 10px;"> _____ Date </div> <div style="text-align: right; margin-top: 10px;"> _____ Typed or printed name </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p style="text-align: center;">WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p style="text-align: center;">*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>	

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PTO/SB/25 (10-00)

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TERMINAL DISCLAIMER TO OBIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION	Docket Number (Optional)
<p>In re Application of:</p> <p>Application No.:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number _____, filed on _____, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: flex; justify-content: space-between; width: 100%;"> <div style="border-top: 1px solid black; width: 60%;"></div> <div style="border-top: 1px solid black; width: 20%;"></div> </div> <div style="display: flex; justify-content: space-between; width: 100%; margin-top: 5px;"> Signature Date </div> <div style="border-top: 1px solid black; width: 100%; margin-top: 10px;"></div> <div style="text-align: center; margin-top: 5px;">Typed or printed name</div> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) is included.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p><small>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.</small></p>	

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CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: _____

Application No.: _____ Filed: _____

For: _____

_____, a _____,
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

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☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : _____

Name : _____

Title : _____

Signature: _____